

Application No.: 10/008468

Case No.: 55525US011

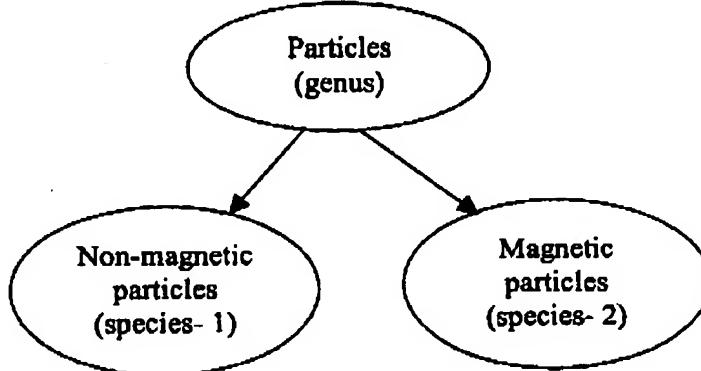
Remarks

Claims 32-39 are pending. Claims 32-39 have been withdrawn from consideration.

In response to the Applicants "Amendment and Response under 37 CFR § 1.111," filed May 19, 2004, the Patent Office issued an Office Action including a Restriction Requirement/Election of Species. According to the Patent Office, "non-magnetic particles" as recited in the currently amended claims constitute a patentably distinct species. (Office Action mailed August 4, 2004 (hereinafter OA 4Aug04), ¶ 1.) Applicants respectfully submit that the Patent Office failed to expressly define the species from which "non-magnetic particles" are patentably distinct.

Applicants note that the Patent Office constructively elected "particles" based on the claims originally presented for prosecution on the merits. (OA 4Aug04, ¶ 2.) Thus, the Patent Office appears to be treating "particles" and "non-magnetic particles" as patentably distinct species and requiring restriction between them. Applicants respectfully traverse this characterization and the resulting restriction requirement.

Applicants wish to emphasize that in the following discussion they are not arguing that two species are not patentably distinct. Rather, the Applicants are submitting that the Patent Office has improperly characterized "particles" as a species relative to "non-magnetic particles" when, in fact, "particles" is a genus. Applicants further submit that restriction between a genus and a species is improper. The relationship between the various categories of particles is shown in the figure below.



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As acknowledged by the Patent Office, within the context of the present claims the category "particles" is generic. (OA 4Aug04, ¶ 1.) Applicants respectfully submit that "non-magnetic particles" and "magnetic particles" are two patentably distinct species within the genus "particles." (See, e.g., page 4, line 28 – page 5, line 8.) Thus, although restriction between the species "non-magnetic particles" and the species "magnetic particles" may be proper, restriction between the genus "particles" and the species "non-magnetic particles" is not.

This situation is exemplified in MPEP § 818.02(b) which states, "[w]here only generic claims are first presented in an application in which no election of a single invention has been made, and applicant later presents species claims to more than one species of the invention, he or she must at that time indicate an election of a single species." (Emphasis added.) In the present case, Applicants presented only generic claims first, i.e., claims directed to "particles." In their most recent response (mailed May 19, 2004), Applicants presented species claims to only one species, i.e., non-magnetic particles. Had the Applicants presented claims to more than one species (e.g., magnetic particles and non-magnetic particles), restriction under MPEP § 818.02(b) may have been proper. However, the Patent Office has failed to provide a proper basis for requiring restriction between a single, later-presented species and the originally presented genus.

Assuming, *arguendo*, that "particles" could be characterized as a species relative to "non-magnetic particles," the restriction requirement would still be improper. "Claims restricted to species must be mutually exclusive." That is, "claims to be restricted to different species must recite the mutually exclusive characteristics of such species." Restriction is only proper when "one claim recites limitations which under the disclosure are found in a first species but not the second, while a second claim recites limitations disclosed only for the second species and not the first." (MPEP § 806.04(f), emphasis added. Based on these criteria, Applicants respectfully submit that restriction between non-magnetic particles and particles is improper, as all non-magnetic particles will also be particles. Therefore, there is no limitation in "particles" that is not found in "non-magnetic particles."

In summary, "particles" and "non-magnetic particles" are not species relative to each other; rather "particles" is a genus while "non-magnetic particles" is a species within that genus. The Patent Office has failed to provide a proper basis for requiring restriction between a genus and a species. Furthermore, even if both "particles" and "non-magnetic particles" were considered

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species, they are not mutually exclusive species as all non-magnetic particles are also particles. For at least these reasons, the Restriction Requirement is improper and should be withdrawn.

In order to further prosecution, Applicants provisionally elect the species non-magnetic particles. Claims 32-39 read on this species.

Applicants respectfully submit that the Patent Office improperly relied upon MPEP § 821.03 when it asserted that "particles" had been constructively elected. MPEP § 821.03 is founded on 37 CFR 1.145 which states, "[i]f after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed ..." (Emphasis added.) For at least the reasons stated above, Applicants respectfully submit that claims directed to a genus (e.g., particles) and claims directed to a species within that genus (e.g., non-magnetic particles) are not distinct and independent.

In summary, Applicants respectfully request that the Restriction Requirement be withdrawn. In the alternative, Applicants respectfully request the Patent Office to acknowledge Applicants election of the species "non-magnetic particles." In either case, Applicants respectfully request that the Patent Office reinstate claims 32-39. (See 37 CFR § 1.142(b).)

Should the Examiner determine that a telephone interview would be beneficial in resolving any of the issues in this case, the Examiner is invited to telephone the undersigned attorney at the telephone number noted below.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 32-39, as amended, at an early date is solicited.

Respectfully submitted,

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Date

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By:



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